

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PHILIP MARK

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Appeal No. 2005-0262  
Application No. 10/101,732

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ON BRIEF

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Before KIMLIN, PAK and OWENS, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 6.

Claim 6 is reproduced below:

6. A hand held vibrating instrument comprising an elongated tubular housing for grasping to be used manually similar to a conventional pen or pencil writing instrument comprising:

said elongated tubular housing having an elongated internal chamber having a proximate end and a distal end:

connecting means being a socket mounted on said distal end for connecting a tool to said instrument;

said tool has a male threaded portion at its proximate end, terminating with a radially extending flange located in the direction of a distal end of the tool, the flange has a rod

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portion at the other side of the flange which terminates in a cylindrical portion that is larger than the said rod, the cylindrical portion terminates in another rod portion that is smaller in diameter than the said cylindrical portion,

said tool being constructed of a resilient material;

said socket having a distally facing opening and a female threaded recess therein adapted and constructed to accept and retain thereinto the male threaded portion of said tool;

a motor means being mounted within said internal chamber, said motor means including a rotatable shaft, a weight eccentrically mounted on said shaft, the rotation of said shaft rotates said weight and produces a rapid vibration at said distal end;

battery means mounted within said internal chamber for providing electrical energy to operate said motor means;

switch means for controlling operation of said motor means, said switch means being mounted in said housing;

a disc means, said disc means mounted on said housing, and being integral therewith, said disc means being reciprocable radially and being movable between a position to operate said switch means into an activating position and into a deactivating position, said disc being manually depressable to move the switch means to said activating or deactivating position.

The examiner relies upon the following references as evidence of obviousness:

Held et al. (Held)	2,917,758	Dec. 22, 1959
Sven	5,247,218	Sep. 21, 1993
Mark	Des. 392,465	Mar. 24, 1998

Appellant's claimed invention is directed to a hand held vibrating instrument of the recited structure.

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Appealed claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sven in view of Mark and Held.

We have carefully reviewed the respective positions advanced by appellant and the examiner. In so doing, we find that the examiner has established a prima facie case of obviousness for the claimed subject matter that has not been rebutted by appellant. Accordingly, we will sustain the examiner's rejection for the reasons set forth in the Answer.

Appellant does not dispute the examiner's factual determination that Sven discloses a hand held vibrating instrument comprising all the recited features with the exception of the configuration of the claimed tool and the claimed disc means for operating the electrical switch. Indeed, appellant acknowledges that "[t]he examiner is correct in reciting the elements found both in Sven and the only claim in the present matter" (page 1 of Brief, last paragraph). Appellant also does not contest the examiner's legal conclusion that it would have been obvious for one of ordinary skill in the art to modify the instrument of Sven with the tool of Mark and the disc of Held. Rather, appellant submits the following:

However, a reference to Mark does not appear to be of record either in the present application nor its parent. As the last name of the inventor-applicant in both applications is Mark, perchance the examiner is

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relying on Mark's own teachings either from the parent or the present continuation-in-part. It is submitted that neither reference can be relied upon a fortiori the combination of Sven, Mark and Held it [sic, et] al, fails and claim 6, here on appeal cannot be held anticipated.

(Page 2 of Brief, penultimate paragraph). Hence, appellant's sole argument on appeal is that Mark is not of record. The examiner responds as follows in the paragraph bridging pages 5 and 6 of the Answer:

The applicant argues that the reference Des. 392,465 issued to Mark is not a prior art. The examiner acknowledges that the inventor of Des. 392,465 is the same inventor of the present application. However, the date of patent of Des. 392,465 is March 24<sup>th</sup>, 1998 while the filing date of the parent application serial number 09/711,305 is November 14<sup>th</sup>, 2000. In addition, it is noted that Des. 392,465 is listed in PTO-892 and mailed with the Final Rejection to the applicant on April 10<sup>th</sup>, 2003. Therefore, Mark is a record in the application serial number 10/101,732 filed March 21<sup>st</sup>, 2002.

Our review of the examiner's Final Rejection reveals the examiner's citation of Mark as a reference in the Final Rejection. Since appellant has not refuted the examiner's reasonable position in a Reply Brief or the like, and has not presented any substantive argument against the propriety of the examiner's combination of references which factually supports the conclusion of obviousness, we must sustain the examiner's rejection. Appellant has furnished no argument, let alone

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evidence, that he has not received the examiner's citation of the Mark reference on Form PTO-892.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
CHUNG K. PAK	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

ECK:clm

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